

REMARKS/ARGUMENTS

The office action of November 3, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

Claims 1-14 are pending. Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Berler (US 4,249,268) in view of Hoffman (US 3,257,666).

In response, the Applicants have clarified how the apparel is mounted to the apparel attachment member. In light of these clarifications and the remarks provided below, the Applicants respectfully submit that claims 1-14 are patentable over Berler in view of Hoffman.

Berler teaches attaching a decorative ornament 46, such as the letter "A" to the outside of a shirt through the use of hook elements on one side of the ornament 46 that attach to loop elements 44 on the outside of the shirt. Col. 3, lines 14-19. Berler does not teach or suggest adhesively attaching an apparel attachment member to protective equipment. Berler also does not teach or suggest an apparel attachment member where the hook side of the apparel attachment member removably secures to the loops that are formed (naturally or through brushing) on the inside of the apparel. The present claims have been amended to further clarify the attachment of the loops of the apparel attachment member to the inside of the apparel. Berler also does not teach or suggest securing an item of apparel onto protective equipment. As previously indicated in prior communications, the benefits of these aspects of the present invention, missing from Berler, are set forth in the specification at paragraphs 5-7, 18-19 and 24. These benefits include, by way of example, preventing movement of the apparel relative to the protective equipment while being subject to high shear stresses caused by the apparel being grabbed, yanked or pulled providing effective repeated use of the apparel attachment member even after being exposed to moisture and dirt.

There is no motivation in combine Berler with Hoffman. The Office Action states that "[i]t would have been obvious to one of skill in the art at the time the invention was made to secure the attachment member of Berler to a protective equipment as taught by Hoffman." However, no motivation to combine Berler with Hoffman was provided in the Office Action nor does the prior art suggest a modification of Berler or combination with Hoffman to arrive at the

claimed invention. *See* MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criterion must be met. First, there must be some suggestion or motivation ... to modify the reference or to combine reference teachings"). Because there is no motivation to combine Berler with Hoffman, it is respectfully submitted that the present claims are in allowable condition.

Nonetheless, for sake of argument, even if Berler and Hoffman are combined (which is impermissible as explained above), Hoffman does not obviate the deficiencies in Berler. Hoffman teaches sewing a patch onto a recoil pad where one side of the patch contains hooks. Col. 3, lines 15-23. Hoffman also teaches sewing a second patch containing loops to the inside of a garment. *Id.* Only after these patches are sewn in place can the garment be placed over and secured to the recoil pad. As with Berler, Hoffman does not teach or suggest adhesively attaching an apparel attachment member to protective equipment where the hook side of the apparel attachment member removably secures to the loops that are formed on the inside of the apparel, as recited in the pending claims. For these additional reasons, because Berler and Hoffman do not teach or suggest all the aspects of the present invention, the present claims are believed to be nonobvious over these references and thus in allowable condition.

Consequently, it is respectfully submitted that the independent claims are in allowable condition and that all claims depending from these independent claims are allowable for the same reasons and for the additional limitations recited in those claims.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections and objections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

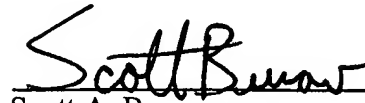
Appln. No.: 10/033,818
Amendment dated January 26, 2004
Reply to Office Action mailed November 3, 2003

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: January 26, 2004

By:

A handwritten signature in dark ink, appearing to read "Scott Burow", written over a horizontal line.

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Deposited January 26, 2004

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By: 
(person *actually* depositing)

In the Application of: Turner et al.

Serial No.: 10/033,818

Filing Date: December 20, 2001

For: Device and Method for Securing Apparel to Protective Equipment

- (X) Transmittal (1 page) in duplicate
- (X) Amendment and Response to Office Action mailed November 3, 2003 (7 pages)
- (X) Return Receipt Postcard

Attorney Docket No: 05127.00035

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